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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION**

DIGITAL IMPACT, INC.,

Plaintiff,

v.

BIGFOOT INTERACTIVE, INC.,

Defendant.

No. C 05-0636 SBA

ORDER

[Docket No. 87]

BIGFOOT INTERACTIVE, INC.,

Counterclaimant,

v.

DIGITAL IMPACT, INC.,

Counterdefendant.

Before the Court is an Order issued by the Ninth Circuit Court of Appeals which states as follows:

Digital Impact sued Bigfoot for patent infringement. Bigfoot filed a counterclaim, seeking a declaratory judgment of invalidity. On September 19, 2007 the United States District Court for the Northern District of California entered summary judgment of noninfringement. Without expressly addressing or dismissing Bigfoot's counterclaim, the district court entered a "final judgment." Subsequently, Digital Impact filed this appeal.

A judgment that does not dispose of pending counterclaims is not a final judgment. *Nystrom v. Trex Co., Inc.*, 339 F.3d 1347, 1351 (Fed. Cir. 2003). Because there is no final judgment disposing of all claims for relief, Digital Impact's appeal must be dismissed. *Id.*

Docket No. 91 at 1-2 (Order).

On February 7, 2008, the Ninth Circuit thus dismissed the appeal.


1 In this Court, after Digital Impact, Inc. ("Digital") sued Bigfoot Interactive, Inc. ("Bigfoot"),
2 the latter did answer and file a counterclaim seeking a declaration of either non-infringement (first
3 counterclaim) or alternatively, a declaration of invalidity (second counterclaim), regarding the
4 disputed patent. *See* Docket No. 13 ¶¶ 23-24 (Answer & Countercl.). On September 18, 2007, the
5 Court granted Bigfoot's motion for summary judgment [Docket No. 71], finding there was no
6 infringement. *See* Docket No. 86 at 12 (Order). That same day, the Court granted judgment for
7 Bigfoot, finding against Digital Impact, but did not issue judgment for Bigfoot on its counterclaim.
8 *See* Docket No. 87 (Final J.).

9 As a result, the Court orders as follows:

- 10 (1) This matter is RE-OPENED as of February 14, 2008;
- 11 (2) The Final Judgment granted on September 18, 2007 and entered on September 19,
12 2007 [Docket No. 87] is VACATED;
- 13 (3) The Court DECLARES, for the reasons stated in the Court's Order [Docket No. 86]
14 on Bigfoot's motion for summary judgment of noninfringement [Docket No. 71], of U.S. Patent
15 6,449,634 ("634 patent"), entitled "Method and System for Remotely Sensing the File Formats
16 Processed by an E-Mail Client," that Bigfoot does not perform all of the steps of the 634 patent, and
17 it does not have sufficient connection with its e-mail recipients to be regarded as "jointly
18 performing" the steps of the patent. Accordingly, Bigfoot did not infringe on independent claims 21
19 and 30 of the 634 patent, and by extension all claims dependent on 21 and 30;
- 20 (4) The Court DISMISSES Bigfoot's second counterclaim as moot;
- 21 (5) The Court shall issue a First Amended Final Judgment reiterating the initial Final
22 Judgment, but also granting judgment for Bigfoot on its first counterclaim for a declaration of non-
23 infringement.

24 IT IS SO ORDERED.

25 February 14, 2008

26 
27 Sandra Brown Armstrong
28 United States District Judge